



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/086,857 05/29/98 FREDERICK

D D-1093

EXAMINER

PM82/0718

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BUTLER, M
ART UNIT PAPER NUMBER

3651
DATE MAILED:

07/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Defective Appeal Brief

Application No.

09/086,857

Examiner

Butler

Applicant(s)

FREDERICK ET AL.

Art Unit

3651

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 5/7/01 is defective because:

The brief exceeds the 30 page safe harbor brief size limit of Rule 32 (7)(A) of The Federal Rules of Appellate Procedure, FED. R. APP. P. 32 (7)(A); 28 U.S.C. Appendix, as invoked by the Administrative Procedures Act, 5 U.S.C. § 559. Applicant has failed to avail himself of the alternate 1300 line or 14,000 word brief volume limits of Rule 32 (B or C).

Defective Appeal Brief

1. The appellant's 99 page "Brief" is defective for exceeding the principal brief size limit without receiving special leave from the Board to file an oversized "brief." The Federal Rules (of Appellate Procedure) provide a safe harbor limit for principal briefs of 30 pages. FED. R. APP. P. 32 (7)(A); 28 U.S.C. Appendix. Alternately, appellants may certify brief volume to a maximum of 14,000 words or 1300 lines with a monofaced type. FED. R. APP. P. 32 (7)(B & C); 28 U.S.C. Appendix. As a further alternative, the party may obtain special leave from the adjudicator. FED. R. APP. P. 32, Judicial Advisory Committee Annotations on Rule 32.

The Administrative Procedures Act proscribes that unless a statute on point or an agency promulgated rule on point exists, the [Federal] Rules of Evidence and Procedure apply, 5 U.S.C. § 559. The United States Patent and Trademark Office is an administrative agency within the context of the Administrative Procedures Act. *Dickenson vs. Zurko*, 50 USPQ2d 1930, 1933; 527 U.S. 150 (1999). In his majority opinion, Justice Breyer held that § 559 generates uniform procedural standards among the agencies. *Dickenson vs. Zurko* at 1933; *Id.* at 1935.

By way of example, a rule on point expressly superceding § 559 is the express page limit for briefs filed before the Trademark Trial and Appeal Board. 37 CFR § 2.128(b). Statutes superceding § 559 include other portions of the Administrative Procedures Act such as the standard of review expressly proscribed in 5 U.S.C. § 706 wherein the § 706 standard of review superceded implementation of Rule 52(A) as triggered via § 559. *Dickenson vs. Zurko* at 1932. There is no statutory limit within Titles 35 or 5 of the Code or Title 37 of the Rules on brief size before the Board of Patent Appeals and Interferences. As there is no express rule or statute on point limiting brief size, the 30 page safe harbor limit of Rule 32 applies unless a party is granted permission via special leave from the Board upon exercise of the Board's discretionary authority or unless party elects to certify volume as expressed in word count or line count.

When a party generates an oversized brief, he unduly burdens the adjudicator with excessive analysis and obscures the focus of the issues they need analyze and decide, thereby making the task of the adjudicator (in this instance, the Board) more difficult. As such, a party needs obtain permission from the adjudicator when burdening it with such an extra workload. Since applicant failed to obtain leave from the Board of Patent Appeals and Interferences for the filing of an oversized brief, applicant's 99 page brief is defective.

As noted in the included annotated sections, the Judicial Advisory Committee wrote Rule 32(7) with its 14,000 word/1300 line limitations, toward a goal of proximating Rule 32 in word content with the 50 page limit of old Rule 28(G) of which it was replacing. Rule 28(G) was written at a time when briefs were generated on typewriters.

Since the circuit courts have adopted assorted harsh penalties for exceeding volume content-inclusive of appeal dismissal, attorney sanctions, and non-consideration of the brief content exceeding the page limit-the examiner includes as a courtesy to applicant the article warning that briefs certified with MS Word® may give erroneous word counts if the factory default options are not properly deselected-an action held to be inexcusable attorney misrepresentation.

Conclusion

2. In view of applicant's failure to correct all defects in the brief within the time prescribed by 37 CFR 1.192(a), the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See 37 CFR 1.197(c).

Prosecution is otherwise closed.

3. As there are undecided petitions within the case, abandonment of the application is pending dependant upon petition resolution.

Attachment(s):

- ☐ Notice of References or Authority Cited, PTO-892
- ☐ Interview Summary, PTO-413
- ☐ Other:

Michael E Butler

C.P. Ellis 2/16/01

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